REMARKS

I. Introduction

Claims 1-56 are canceled without prejudice.

Claims 57-102 are pending in the case.

Claims 57-83 are rejected based on non-statutory double patenting.

Claims 57-83 are further rejected under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent 6,845,398 to Galensky et al. ("Galensky") in view of U.S. Patent 7,088,990 to Isomursu et al. ("Isomursu").

New claims 84-102 are presented herein.

II. Applicant's Reply to the Double Patenting Rejection

Claims 57-83 are rejected on the ground of non-statutory type double patenting over U.S. Patent 7,149,509, and is provisionally rejected on the ground of non-statutory type double patenting over U.S. Patent Application 10/915,866 (Now U.S. Patent 7,319,866). Applicant submits herewith a timely filed terminal disclaimer pursuant to 37 C.F.R. 1.321(c) for these U.S. Patents. Also submitted herewith is the $65.00 fee set forth in 37 C.F.R. 1.20(d). Accordingly, applicant respectfully requests that the double patenting rejection be withdrawn.

III. Applicant's Reply to the Rejection Under 35 U.S.C. § 103(a)

Claims 57-83 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Galensky in view of Isomursu. Applicant respectfully traverses this rejection in view of the amendments above and the remarks below.

One aspect of applicant's claimed invention, as amended, is concerned with systems and methods that allow a user to customize his or her wireless telephone by programming a selected video file into the wireless telephone for subsequent use as an indicia of an incoming communication. Generally speaking, this may be thought of as a way for users to customize their wireless telephone by selecting and programming a certain video segment (such as a video clip or portion thereof) into their wireless telephone, for use as a ringtone, which plays when an incoming telephone call (or other communication) is received.

One benefit of the claimed systems, methods and Internet sites is that it provides the user of the wireless telephone with the freedom and flexibility to select (and/or change to) a particular video ringtone that is pleasing to the user rather than be constrained to a conventional audio-only ringtone (or small group of audio-only ringtones) which may

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have been pre-programmed by, or available from, the handset manufacturer (as is described in Isomursu).

The claimed systems, methods and Internet sites provide the capability of allowing a user of the wireless telephone to connect to a remote database(s) of video ringtones, allow the user to browse lists of video ringtones in the remote database(s), select a particular video ringtone and optionally review (*e.g.*, preview) the selected video ringtone and download the selected video ringtone into a programmable memory in the wireless telephone for future use as an indicia of an incoming communication. Thus, one aspect of applicant's claimed invention is concerned with the customization of a wireless telephone by allowing the selection and download of a video ringtone that is played when receiving an incoming call.

Independent Claims 57, 66 and 75

In contrast, Galensky and Isomursu, either alone or in combination, fail to show or suggest these features anywhere. For example, Galensky is purportedly concerned with a means for streaming multimedia content from a server to a playback device (see Abstract). Galensky explains that a user may select certain multimedia content, which is streamed to the user's device upon request, for immediate playback (*i.e.* "real time" playback). This streamed content is not stored

on the playback device. Galensky explains that the
multimedia *is only played once* (*i.e.*, as the content stream
is received) and thus is not stored on the playback device
for future use as specified in applicant's claims (see
Galensky, column 5, lines 31-42 and column 6, lines 45-57).

Further, applicant points out that the system of
Galensky interacts with a very simple flash memory-type
playback device such as a first generation MP3 player, which
merely provides one basic function, namely the playback of
streamed multimedia content and is not a wireless telephone.
Therefore it cannot receive incoming telephone calls, and
consequently has no need for ringtone, video or otherwise
(see, *e.g.*, Galensky column 3, line 64 to column 4, line 47
and FIG. 2 and its associated description). Accordingly, the
streaming-based system of Galensky does not show or suggest
providing a video file for future use an indicia of an
incoming communication as specified in applicant's pending
claims.

Galensky does mention that under certain circumstances a
multimedia file may be stored on the playback device. In
this case, however, Galensky requires that the playback
device *must* contact the multimedia server and complete a
payment transaction in order to obtain a new authorization
code *each time* the user wants to play the stored content

again (see Galensky, column 7, lines 30-41). Because of this cumbersome restriction, the system of Galensky cannot provide a video file for future use as an indicia of an incoming communication (*e.g.*, because even if the playback device of Galensky could receive incoming telephone calls (which it cannot) they would be missed before a new content authorization code could be obtained allowing content playback; and, furthermore, competition among playback device applications for control of the single communications link to achieve competing goals (receive call or get authorization code) would cause further irreconcilable problems, preventing any authorization code from being obtained in a timely manner).

Moreover, applicant further points out that the system of Galensky merely provides multimedia content for "on-demand" consumption by the user (*e.g.*, see Galensky, column 5, lines 36-46 and column 6, lines 53-57). Because the user receives or has access to content shortly after it is requested, there is no need (or purpose) for an indicia of an incoming communication (such as a video ringtone), because the user receives the information in response to his or her request and thus knows when to expect to receive (or have access to) the requested information (as opposed to a communication initiated by another, which cannot be predicted

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by a user, requiring that the user be alerted with an indicia
of the incoming communication, such as a video ringtone). As
a result, the streaming based, on-demand playback system of
Galensky teaches away from the features of applicant's
claimed invention.

Accordingly, based on the above, applicant respectfully
submits that independent claims 57, 66 and 75, and the claims
that depend therefrom, are allowable over Galensky.
Therefore, these claims are also allowable over the
Examiner's proposed combination of Galensky and Isomursu for
at least the same reasons.

Further Distinctions over Isomursu and Galensky

Claims 58-65, 67-74 and 76-83 are further rejected based
on various sections of Galensky and Isomursu. Although it is
believed these rejections are rendered moot in view of the
distinctions provided above, applicant addresses some of the
other bases for rejection below.

In the first instance, the system of Isomursu is only
concerned with the exchange short user-based text messages
(see, *e.g.*, Isomursu, column 2, lines 19-39; column 14, lines
24-45; and FIG. 1). Such systems merely convey simple
character-based text information and are *incapable* of
transferring video information as the Examiner contends due

to the limited capacity of these messages. Nowhere in Isomursu is video, video transmission, or video playback even mentioned or suggested. Accordingly, applicant respectfully traverses the Examiner's position with respect to any contention that system of Isomursu shows or suggests features that relate to video (or is capable of being modified to do so without extensive and thus prohibitive modification). Accordingly, the system of Isomursu fails to show or suggest searching, receiving, browsing or reviewing video files, let alone for using such video files as an indicia of an incoming communication as specified in applicant's claims.

Moreover, the Examiner further contends that Isomursu teaches editing video files. Applicant respectfully disagrees. The section of Isomursu cited in support of this rejection (column 10, lines 32-57) has nothing to do with video files or editing whatsoever, but rather merely relates to an application for creating specialized service menus. Accordingly, no editing or modifying feature of video ringtones is shown or suggested by Isomursu, Galensky or any other prior art of record.

In addition, the Examiner further contends that Galensky and/or Isomursu show or suggest preventing the unauthorized distribution of a downloaded video file and confirms successful receipt of the video file, respectively.

Applicant respectfully disagrees. Galensky does not store the downloaded video file on the playback device (and does not discuss distribution restrictions) and Isomursu merely indicates when some text message purporting to be an audio file is received and does not confirm its proper receipt. Streaming systems, such as the one described in Galensky is incapable of confirming proper receipt of a communication. Moreover, Isomursu does not operate in conjunction with a distribution computer to confirm proper receipt as claimed.

Furthermore, claims 65, 74 and 83 have been rejected in view of Official Notice. Although these claims are allowable based on the discussion above as depending from an allowable base claim, MPEP § 2144.03 requires that the facts of which notice are being taken be capable of instant and unquestionable demonstration as being well known in the art. See In re Ahlert, 165 USPQ 418, 420 (1970). Applicant believes that the "facts" of which the Examiner may have taken Official Notice do not meet that standard, and invoke the right under MPEP § 2144.03 to have the Examiner provide documentary proof that those facts are actually well known in the claimed context.

For example, claims 65, 74 and 83 specify coordinating the downloading of the selected video file such that the user of the wireless telephone is informed when the

wireless telephone has insufficient available memory capacity to successfully download the selected video file. Nowhere is this feature shown or suggested in the prior art, let alone well known in the art. For example, neither the text-based messaging system of Isomursu or the streaming based system of Galensky are capable of coordinating content download based on memory capacity. Text-messaging systems merely "pop" (discard) the last message off the memory stack to make room for a new message if memory is at capacity without any user notification. Similarly, streaming-based systems merely stream data to a user substantially regardless of playback device memory capacity and without user notification. Accordingly, applicant respectfully submits the features specified in these claims are indeed novel in the wireless content distribution context as claimed.

Not Obvious to Combine

Moreover, applicant submits it is not obvious to combine the references as the Examiner proposes. As mentioned above, the purpose of Galensky is to stream multimedia content to a simple playback device for immediate playback, whereas the purpose or Isomursu is to provide a platform from which users can exchange short text-only messages. Therefore, these systems each have fundamentally different objectives and use different platforms and different means of achieving those

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fundamentally different objectives, and thus cannot be combined as the Examiner proposes. Furthermore, because the system of Isomursu is a text-only system, and is not concerned with video information, it is incompatible with the streaming based multimedia system of Galensky, the thus teach away from one another. As a result, substantial modification would be required to effect the Examiner's proposed combination, further discouraging any such attempt at combination. Moreover, no teaching is provided in the references describing how to accomplish the necessary substantial modifications nor is there any recognition within the references that such a combination would even be desirable or useful.

Lastly, even if such a combination were made, it would still not produce applicant's claimed invention (*i.e.*, it would merely produce a system suffering from all the shortcomings of Isomursu and Galensky as pointed out above).

Accordingly, applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be withdrawn.

IV. Related Cases

In accordance with MPEP §§ 2001 and 2002, applicant again draws the Examiner's attention to pending related cases 11/633,142 and 11/633, 122 (pending rejections), and recently
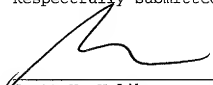
filed case 12/128,991 which may be considered to have similar claims to this case and thus are relevant to the examination of this case.

V. Conclusion

For at least the above reasons, claims 57-102 are patentable over the references of record. Accordingly, applicant respectfully requests that the Examiner withdraw the rejections and allow the pending claims. To expedite prosecution of this application, the Examiner is invited to call the applicant's undersigned representative to discuss any issues relating to this case.

Respectfully submitted,

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